

Remarks/Arguments

In an Office Action mailed April 26, 2005 (the "Office Action"), the Examiner:

- A. Rejected claims 2-15, 18-37, 47-56, 62-68, 74-77, 101, 106-114 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss (US 6,647,373) and further in view of Guttman (Merchant Differentiation through Interactive Negotiation in Agent-Mediated Electronic Commerce) (Guttman);
- B. Rejected claims 16 and 17 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss and Guttman as applied to claim 2 and further in view of Chen (US Pat. 5,991,737) (Chen);
- C. Rejected claims 38-46, 69-70, 78-82 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss and Guttman as applied to claim 2 and further in view of Alaia; and
- D. Rejected claims 57-61 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss and Guttman as applied to claim 2 and further in view of Mori et al.

The Applicant's attorney thanks the Examiner for his discussion of the following remarks in a telephone interview on October 25, 2005. In that interview, the Examiner agreed to review these remarks in more detail and to call the Applicant's attorney prior to sending out the next office action.

REMARKS

- A. Rejection of claims 2-15, 18-37, 47-56, 62-68, 74-77, 101, 106-114 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss (US 6,647,373) and further in view of Guttman (Merchant Differentiation through Interactive Negotiation in Agent-Mediated Electronic Commerce) (Guttman)**

Claim 2

In rejecting claim 2, the Examiner gave the following motivation to combine Carlton-Foss with Guttman:

It would have been obvious to one of ordinary skill in the art at the time of invention to combine Guttman to Carlton-Foss because buyer

would be able to identify products having complex features according to his preferences which would aid in his buying decisions. As explicitly disclosed in Guttman this combination would afford buyer the opportunity to cooperatively search the space of product offerings across their full range of value with the purpose of maximizing the purchase experience. *Office Action p. 4.*

Applicants respectfully assert that the Examiner has not provided a proper motivation to combine Carlton-Foss with Guttman, for at least the following three reasons.

First, the Examiner's rationale that the "buyer would be able to identify products having complex features according to his preferences which would aid in his buying decisions" explains the desirability of gathering product information, but it does not explain the desirability of combining gathering product information with performing a buyer's auction. In simplified symbolic terms, the Examiner has not provided a motivation to combine A with B to make the combination [A+B]. Here, the Examiner has provided a motivation to do A, not a motivation to combine A with B (where $A \approx$ gather product information and $B \approx$ perform a buyer's auction).

Second, contrary to the Examiner's assertion, Guttman does not explicitly disclose that "this combination [(i.e., the combination of gathering product information and performing a buyer's auction)] would afford buyer the opportunity to cooperatively search the space of product offerings across their full range of value with the purpose of maximizing the purchase experience." It is respectfully submitted that the Examiner has misread Guttman, which states:

Unlike price comparisons and online auctions, integrative negotiation protocols afford consumers and merchants the opportunity to cooperatively search the space of product offerings across their full range of value with the purpose of maximizing the each party's independent goals. *Guttman p. 54 (underlines added for emphasis).*

Thus, the passage paraphrased by the Examiner is noting the benefits of "integrative negotiation protocols," not the benefits of combining gathering product information and performing a buyer's auction. Indeed, this passage from Guttman explicitly states that online auctions do not provide this benefit ("Unlike . . . online auctions, . . .").

Note that the "integrative negotiation protocols" described by Guttman are not auctions. Rather, as explained in the Applicants' specification at pp. 24-25, Guttman's Tête-à-Tête system uses a set of parallel one-on-one negotiations.

Third, Guttman repeatedly teaches away from the use of auctions, so it is improper to combine Guttman with Carlton-Foss. For example, on p. 47, Guttman states "a critical look at applying auction protocols to the retail of complex products uncovers many problems and limitations." On pp. 47-51, Guttman goes on to summarize and explain eight different problems with auctions. After this extensive criticism of auctions, Guttman proposes his Tête-à-Tête system of integrative negotiation:

At the core of Tête-à-Tête is an integrative negotiation interaction model that differs significantly from the distributive negotiation interaction model exemplified by today's online auctions.

Guttman, p. 53.

Given the extensive criticism of (i.e., teaching away from) auctions in Guttman, Applicants respectfully submit that it is improper to combine Guttman with Carlton-Foss.

In light of the foregoing three reasons, Applicants respectfully submit that the Examiner has used improper hindsight reasoning to combine Guttman with Carlton-Foss.

The preceding analysis explains why it is improper to combine Guttman with Carlton-Foss. That analysis applies to all of the pending claims, not just claim 2. Below, the Applicants respond to other obviousness rejection arguments made by the Examiner in the Office Action.

Claim 6

According to the Examiner:

Carlton-Foss fails to teach, however, official notice is taken that performing steps of product information retrieval and subsequent purchase of products using a single computer (without the buyer actively initiating a transfer to a different computer) in auction environment is old and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to have all carried out per claim in order to simplify the purchase experience.

Office Action, pp. 4-5 (emphasis added).

Claim 6 has been amended to clarify the claim. Applicants respectfully traverse the Examiner's assertion of official notice and request that the Examiner produce authority for his statement. Applicants do not believe "that performing steps of product information retrieval and subsequent purchase of products using a single

computer (without the buyer actively initiating a transfer to a different computer) in [an] auction environment is old and well known.”

Claims 7-11

The Examiner rejects these claims based on "nonfunctional descriptive material":

The cited prior art do not expressly show that the computer operated by a service provider unrelated to either buyer or the sellers. The cited prior art further do not expressly show additional features associated with the service provider.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method steps a) -j) would be performed the same regardless of the (non-functional) data.

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983), In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the computer operated by the service provider with associated features because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. *Office Action, p. 5.*

Claim 7 has been amended to clarify the claim.

According to the Manual of Patent Examining Procedure (MPEP) § 2106, "nonfunctional descriptive material" includes "music, literature, art, photographs, and mere arrangements or compilations of facts or data" or other similar materials. However, claims 7-11 have nothing to do with such materials. Thus, the Applicants respectfully request that the Examiner clarify his rejection or withdraw it.

Claims 12-15

According to the Examiner:

inputting the request using graphical user interface with other related features recited are inherent to online auction wherein the auction is implemented via a web site of the provider as discussed in Carlton-Foss and Guttman. *Office Action, p. 5.*

However, Applicants respectfully submit that "electronic templates for a structured language query" (claim 14) are not inherent to GUIs. Thus, the rejection of claim 14 should be withdrawn.

Claims 18-29

For these claims, the Examiner states:

a plurality of criteria concerning buyer preferences (refer to Figure 14, and discussion of criteria (dimensions) in col. 10-13).

Office Action, p. 5.

However, after reviewing Figure 14 and columns 10-13 in Carlton-Foss, the Applicants fail to find any disclosure concerning claims 20-24. Applicants respectfully request that the Examiner point out where these claims are disclosed or withdraw the rejections to claims 20-24.

Claims 30-32, 77

For these claims, the Examiner states:

wherein said request includes asking sellers to apply a suggestion module to said request (see relevant discussion of suggestion module in claim 5 analysis).

Office Action, p. 6.

However, the Examiner's claim 5 analysis merely states "(see Guttman, chapter 2, PersonaLogic)." After reviewing chapter 2 in Guttman, the Applicants fail to find any disclosure concerning claims 30-32 & 77. Applicants respectfully request that the Examiner point out where these claims are disclosed or withdraw the rejections to these claims.

Claim 33

According to the Examiner:

Carlton-Foss fails to teach, however, official notice is taken that maintaining anonymity of the buyer or seller is old and well known in electronic commerce.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have . . . the buyer remain anonymous as a personal preference and incorporate this feature as a design choice.

Office Action, p. 6 (emphasis added).

Applicants respectfully traverse the Examiner's assertion of official notice and request that the Examiner produce authority for his statement. Buyers remaining anonymous in a seller's auction may be old and well known. However, Applicants do

not believe that the buyer remaining anonymous to prospective sellers in a buyer's auction is old and well known. In addition, according to the USPTO:

A simple statement that a difference is a "design choice" . . . is insufficient rationale to support a well written and legally sufficient rejection. These are conclusions, not statements of fact. (*Source: <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>*)

Claim 37

According to the Examiner:

Carlton-Foss and Guttman [fail] to explicitly teach however, official notice is taken programming a computer to periodically sent request for an offer (such as a bid in auction environment) and well known methods. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement this feature for the convenience of the buyer. *Office Action, pp. 6-7 (emphasis added)*.

Claim 37 has been amended to clarify the claim.

Applicants respectfully traverse the Examiner's assertion of official notice and request that the Examiner produce authority for his statement. Applicants do not believe that having a buyer-created software process initiate communicating the request for an offer at specific time periods is old and well known. Also, contrary to the Examiner's assertion, a request for an offer is not the same as a bid in an auction because the request for an offer occurs before the auction.

Claims 55-56

According to the Examiner:

[T]he recited claims pertain to selling offering purchase history information of consumer for marketing.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement these steps for marketing and maximizing revenue from the operation of the auction.
Office Action, p. 7.

The Examiner does not point to any art (including Carlton-Foss and Guttman) that discloses these claims. Applicants respectfully request that the Examiner point out where these claims are disclosed or withdraw the rejections to claims 55-56.

Claim 62

For this claim, the Examiner states:

time remaining in the specified auction period (Carlton-Foss, Fig. 4a-b). *Office Action, p. 8.*

However, after reviewing Figure 4a-b in Carlton-Foss, the Applicants fail to find any disclosure concerning time remaining in the specified auction period. Figure 4a-b does list the date that the bidding ends ("Bidding Ends 11/1/98"), but that is not the same as the time remaining in the specified auction period. Applicants respectfully request that the Examiner point out where claim 62 is disclosed or withdraw the rejection to claim 62.

Claims 63-68

For these claims, the Examiner states:

buyer's auction includes specified auction parameters (Carlton-Foss, Fig. 4a-b and 12a-b). *Office Action*, p. 8.

However, after reviewing Figures 4a-b and 12a-b in Carlton-Foss, the Applicants fail to find any disclosure concerning claims 65-68. Applicants respectfully request that the Examiner point out where these claims are disclosed or withdraw the rejections to claims 65-68.

Claim 74

For this claim, the Examiner states:

Carlton-Foss fails to teach, however, Guttman, in the same field of endeavor teaches that a software process initiates the communicating of seller offers (as per step g) of the present claim) and rating information to the buyer when a buyer-specified event occurs. (see Guttman, discussion of online agent Kasbah (p. 44), p. 59-62 "Tête-à-Tête Shopping Experience", in particular, p. 60 para "From the shopper's perspective . . . product offering that base satisfy the selected profile's default preferences as shown in Fig. 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the feature of the software process (at least bid ranking manager 134, requester Worksheet generator 129 of Figure 5) initiate communicating of seller offers and rating information to the buyer when a buyer specified event occur because this evaluation would help customize the most appropriate product for the buyer based upon the buyer's specified requirements.

Office Action, pp. 8-9.

Contrary to the Examiner's assertion, Applicants respectfully submit that neither p. 44 nor pp. 59-62 of Guttman teaches that a software process initiates the communicating of seller offers and rating information to the buyer when a buyer-specified event occurs, for the following reasons.

The Kasbah system described on p. 44 of Guttman uses buyer agents to negotiate with seller agents (e.g., "Kasbah agents pro-actively seek out potential buyer or seller and negotiate with them on their owners behalf." *Guttman, p. 44*). There is no communicating of seller offers to the buyer in the Kasbah system. Rather, seller offers are communicated to the buyer's agent. In addition, there is no communication of rating information (e.g., per claims 47-49, a ranking, numerical score, or letter grade) in the Kasbah system. Thus, p. 44 of Guttman does not disclose claim 74.

The Tête-à-Tête Shopping Experience on pp. 59-62 of Guttman does not disclose claim 74, either. In particular, consider the sentence cited by the Examiner on p. 60 of Guttman in more detail:

From the shopper's perspective, however, selecting a profile immediately launches into a Tête-à-Tête shopping session with a presentation of product offerings that best satisfy the selected profile's default preferences as shown in Figure 13.

This sentence describes launching a shopping session in response to the buyer choosing a profile (e.g., per Figure 12 on p. 60 in Guttman, Power User, Budget Conscious, Average User, or Road Warrior). Note that the launch of the shopping session is initiated by the buyer (i.e., by the buyer choosing a profile), not by a software process. In addition, the launch of the shopping session does not happen when a buyer-specified event occurs (e.g., per claim 75, the buyer could specify that seller offers and rating information be communicated to the buyer when a seller offer with a rating above a buyer-specified rating level is received).

In addition, assuming for the sake of argument that p. 44 and/or pp. 59-62 of Guttman disclose claim 74, the motivation to combine provided by the Examiner (i.e., "this evaluation would help customize the most appropriate product for the buyer based upon the buyer's specified requirements" *Office Action p. 9*) does not make sense because having a software process initiate communications to the buyer when a buyer-specified event occurs is not an evaluation.

Thus, in addition to the reasons given above with respect to claim 2, the rejection of claim 74 should also be withdrawn because the additional claim limitations required by claim 74 are not disclosed by p. 44 or pp. 59-62 of Guttman.

Claim 75

For this claim, the Examiner states:

The buyer specified event is the receipt of the seller offer with a rating above a buyer-specified rating level (see Figures 13 and 14 and

description on pp. 59-62 of Guttman, for motivation refer to claim 74).
Office Action, p. 9.

However, after reviewing Figures 13 and 14 and the description on pp. 59-62 of Guttman, the Applicants fail to find any disclosure concerning a software process initiating communications to the buyer when a seller offer with a rating above a buyer-specified rating level is received. Applicants respectfully request that the Examiner point out where claim 75 is disclosed or withdraw the rejection to claim 75.

B. Rejection of claims 16 and 17 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss and Guttman as applied to claim 2 and further in view of Chen (US Pat. 65,991,737) (Chen)

For these claims, the Examiner states:

Carlton-Foss and Guttman fail to teach, however, Chen, in the same field of endeavor, Chen teaches a method of electronic shopping wherein a purchase request is input using a voice user interface (inherently includes natural language input) (Chen Col. 4 L 61- col. 5 L 16).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of claim 1 as disclosed by Alaia in view of Boston Ed provide for input using a voice interface and further including natural language input per Chen reference because this would facilitate ordering of bidding in an interactive auction easier and faster than inputting via a typing the required inputs.
Office Action, p. 10.

After reviewing Chen (including col. 4 L 61- col. 5 L 16), the Applicants fail to find any disclosure concerning inputting a request for an offer using a voice user interface. Rather, Chen discloses placing an order for a product using a voice user interface:

... makes it possible for a consumer to order the purchase of a product simply by identifying the broadcast from which the consumer learned of the product. For example, a consumer might order the purchase of a compact disc containing a song being played on FM radio station 107.9 by dialing *CD.TM.1079 on a telephone while the song is being played, even if the consumer does not know the name of the song or the artist. *Chen, col. 1, lines 48-56.*

... if consumer 24 wishes to respond to the broadcast information, the consumer interacts with consumer transmitter 18 to cause an order to be transmitted to processing station 22 *Chen, col. 4, lines 10-13.*

Placing an order is distinctly different from inputting a request for an offer. When an order for a product is placed (ala Chen), the buyer has committed to paying a fixed price for the product. When a request for an offer is input, there is no fixed price and no commitment that the buyer will purchase the product. Thus, Chen does not disclose inputting a request for an offer using a voice user interface.

In addition, the Examiner's motivation to combine, which contains reference to "Alaia in view of Boston Ed," does not make sense. If the Examiner can point out where Chen discloses inputting a request for an offer using a voice user interface, then Applicants respectfully request that the Examiner also clarify his motivation to combine Chen with Carlton-Foss and Guttman.

C. Rejection of claims 38-46, 69-70, 78-82 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss and Guttman as applied to claim 2 and further in view of Alaia

Claims 38-46

For these claims, the Examiner states:

Carlton-Foss and Guttman [fail] to explicitly teach however, Alaia teaches communicating information about the buyer to at least one of the sellers (Alaia, col. 3 L 3-8, suppliers receive notices regarding upcoming auction as well as client software), . . . in consideration to the buyer (Alaia, col. 3 L 3-8, suppliers participate in the buyer's auction). *Office Action, pp. 10 (emphasis added).*

Claim 38 has been cancelled and claims 39 & 43-46 have been amended for clarity.

Alaia col. 3 lines 3-8 reads as follows:

The buyer makes a decision regarding which potential suppliers will receive invitations to the upcoming Auction. Suppliers that accept Auction invitations are then sent notices regarding the upcoming Auction, as well as client software to install in preparation of participating [in] the Auction.

Applicants respectfully submit that col. 3 lines 3-8 of Alaia, as well as the rest of the disclosure in Alaia, fails to disclose claims 39-46. Contrary to the Examiner's assertion "in consideration to the buyer (Alaia, col. 3 L 3-8, suppliers participate in the buyer's auction)," nothing in Alaia discloses communicating information about the

buyer to a seller in exchange for a consideration to the buyer, as required by claim 39. It is respectfully submitted that "suppliers participate in the buyer's auction" clearly does not disclose "communicating information about the buyer to a seller in exchange for a consideration to the buyer."

Applicants respectfully request that the Examiner point out where claims 39-46 are disclosed or withdraw the rejections for these claims.

Claims 69-70

For these claims, the Examiner states:

Carlton-Foss and Guttman do not explicitly teach, however, Alaia teaches the steps, adjusted offer expires after a time period specified by the offerer (Alaia schedule close, Fig. 7A, time period is 10:30 Hours), time specified by the offerer (time specified is 10:30). Office Action, p. 11 (emphasis added).

Applicants respectfully submit that Figure 7A in Alaia, as well as the rest of the disclosure in Alaia, fails to disclose that a seller's adjusted offer expires after either a time period (claim 69) or a time (claim 70) specified by the offerer (i.e., by the seller). Rather, Figure 7A shows that the auction (not the seller's adjusted offer) ends at a time specified by the auctioneer (not the seller).

Thus, Applicants respectfully request that the Examiner withdraw the rejections for claims 69-70.

D. Rejection of claims 57-61 under 35 U.S.C. 103(a) as being unpatentable over Carlton-Foss and Guttman as applied to claim 2 and further in view of Mori et al.

As explained in Section A above, Applicants respectfully submit that the Examiner has used improper hindsight reasoning to combine Guttman with Carlton-Foss.

E. Canceled and amended claims

Claim 38 has been cancelled without prejudice.

Claims 12, 16, 18, 26, 30, and 34 have been amended to make clear that "said request" refers to the "request for an offer" in claim 2(d).

Claims 6, 7, 37, 39, 43-46 have been amended for clarity.

F. New claims 115 & 116

Claims 115 & 116 have been added. These new claims are fully supported by the specification.

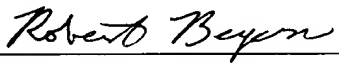
CONCLUSION

In light of the foregoing, the rejections in the Office Action dated April 26, 2005 are believed to be traversed, and Applicants request that the rejections be withdrawn and the claims be passed to allowance.

If the Examiner believes a discussion of the above would be useful, he is invited to call the Applicants' attorney, Dr. Robert Beyers, at (650) 843-7528.

Respectfully submitted,

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